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V13

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/25/99

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P95-41,704

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SUITE 700

1601 MARKET STREET

PHILADELPHIA PA 19103-2367

EXAMINER

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ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/257,585**

Applicant(s)  
**Sally A. Leong, et al.**

Examiner  
**Amy Nelson**

Group Art Unit  
**1638**



X Responsive to communication(s) filed on Feb 25, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

X Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

X Claims 1-29 are subject to restriction or election requirement.

## Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, 13-17, 25, and 26, drawn to wild type coding DNA, transformed host cell, and transgenic plant, classified in class 800, subclass 298, for example.
  - II. Claims 11, and 13-17, drawn to mutant coding DNA, classified in class 435, subclass 440, for example.
  - III. Claims 11-17, drawn to oligonucleotide, classified in class 536, subclass 24.3, for example.
  - IV. Claims 18, and 20-23, drawn to protein, classified in class 530, subclass 371, for example.
  - V. Claims 19 and 24, drawn to antibody, classified in class 530, subclass 387.1, for example.
  - VI. Claims 27 and 28, drawn to protein method, classified in class 514, subclass 12, for example.
  - VII. Claim 29, drawn to bacterial method, classified in class 435, subclass 252.3, for example.

Claims 11 and 13-17 are generic to Groups I, II and III, and will be examined to the

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the wild type coding DNA of Group I, the mutant coding DNA of Group II, the oligonucleotide of Group III, the protein of Group IV, and the antibody of Group V differ in composition, structure and function, and therefore are not related. Also, different searches and considerations would be required for examination of the different groups. Moreover, the wild type coding DNA of Group I and the mutant coding DNA of Group II encode structurally and functionally distinct proteins which differ in activity, and the oligonucleotide of Group III, the protein of Group IV and the antibody of Group V cannot be used to produce the transformed host cell or transgenic plant of Group I.

3. Inventions I and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the wild type coding DNA of Group I cannot be used in the protein method of Group VI.

4. Inventions I and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the wild

type coding DNA of Group I cannot be used in the protein method of Group VII.

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5. Inventions II and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the mutant coding DNA of Group II cannot be used in the protein method of Group VI.

6. Inventions II and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the mutant coding DNA of Group II cannot be used in the bacterial method of Group VII.

7. Inventions III and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the oligonucleotide of Group III cannot be used in the protein method of Group VI.

8. Inventions III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the oligonucleotide of Group III cannot be used in the bacterial method of Group VII.

9. Inventions IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

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§ 806.05(h)). In the instant case, the protein of Group IV can be used in another method than the protein method of Group VI, such as in a method of making an antibody.

10. Inventions IV and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the protein of Group IV cannot be used in the bacterial method of Group VII.

11. Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the antibody of Group V cannot be used in the protein method of Group VI.

12. Inventions V and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the antibody of Group V cannot be used in the bacterial method of Group VII.

13. Inventions VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the protein method of Group VI and the bacterial method of Group VII differ in starting materials, method steps and end products, and therefore are not related.

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14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for one of the groups is not required for another, restriction for examination purposes as indicated is proper.

15. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

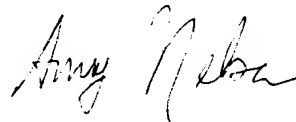
16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy J. Nelson whose telephone number is (703) 306-3218. The examiner can normally be reached on Monday-Friday from 8:00 AM - 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909. The fax phone number for this Group is (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application, or if the examiner cannot be reached as indicated above, should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**AMY NELSON  
PATENT EXAMINER**

Amy J. Nelson, Ph.D.

May 22, 2000